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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,000	03/07/2000	ULRICH BROCKEL	48320	7044

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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

PRATT, HELEN F

ART UNIT PAPER NUMBER

1761

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/487,000

Examiner

Helen F. Pratt

Applicant(s)

BROCKEL ET AL.

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-19, 21, 22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 1761

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-19, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Ooijen (GB 0608975A) or Gonthier et al. in view of Kotani et al. or Kotani et al. alone.

The claims are rejected for the reasons of record cited in the last office action. Claim 1 has been amended to reinstate the particle size of from 10 microns to 2000 microns. Kotani disclose that it is known to make double salts with particle sizes from 5 to 10 microns and from 75 microns (200 mesh) to 100 mesh (150 microns) which are within the claimed range (col. 3, lines 45-50 and lines 50-70). Therefore, it would have been obvious to make impregnated salts at within the claimed range in the composition of Ooijen or Gonthier et al. who also use the claimed composition.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claims 1, 2, 4-19, 21 above, and further in view of Gonthier et al. (3,600,198).

The claims are rejected for the reasons of record cited in the last office action.

ARGUMENTS

Applicant's arguments filed 1-27-04 have been fully considered but they are not persuasive. Applicants argue that the claims are to impregnation which is to a different process than admixing. However, Ooijen discloses the chemicals can be impregnated on the salts (page 3, lines 15-18). In addition, no weight is given to process limitations in a composition claim, which only requires that the composition is disclosed by the references.

Applicants further argue that van Ooijen uses an alkaline earth metal salt. However, this ingredient has not been excluded from the claims. The particular amounts of ingredients are seen to have been within the skill of the ordinary worker, especially as the lower range is disclosed and the reference is not limited as applicants argue. No patentable distinction has been shown between 40% and the claimed 30% of the acid. Also, nothing has been shown that the powder of van Ooijen is not within the particle size claimed.

It is not agreed that there would be no motivation to use the claimed amounts because those amounts are within the claimed range and are close to the 40% above. No mention is made of the release of hydroxycarboxylic acid in the claims.

Applicants argue that Gonthier does not disclose an impregnated salt of a carboxylic acid. However, the particular ingredients have been shown and the method of making the salt is not required. The claimed salts are disclosed in col. 1, lines 41-69. Certainly, they are in salt form if used in terms of grams (col. 2, lines 8-20). The particular amounts of ingredients are seen to have been within the skill of the ordinary worker as it is known how to make the salts.

Applicants argue as to Kotani that sorbic acid is solid at normal processing temperatures and cannot be a liquid carboxylic acid impregnated into the sorbate or organic or inorganic salts. However, as above processing limitations cannot be incorporated into composition claims. As appellant notes, the sorbic acid of Kotani is dissolved in ethanol, which does make it liquid and combined with potassium sorbet under heat, and cooled. This shows that a different process can be used to make the claimed composition. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See *In re Thorpe* 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See *Ex parte Jungfer* 18 USPQ 2D 1796.

Applicants argue that the resulting co-crystalline compound should possess the characteristics of an impregnated carboxylate salt claimed. However, no claimed characteristics of the composition have been claimed and the Examiner does not have the facilities to test products to determine the characteristics of compositions. Certainly, Applicants may present a showing that the compounds are different.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP
3-5-04


HELEN PRATT
PRIMARY EXAMINER